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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,042	07/21/2005	Graham Robertson	920602-99890	9184
23644 7590 04/17/2009 BARNES & THORNBURG LLP P.O. BOX 2786 CHICAGO, IL 60690-2786				
EXAMINER GONZALEZ, MADELINE				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 04/17/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

### Office Action Summary

**Application No.**

10/543,042

**Applicant(s)**

ROBERTSON, GRAHAM

**Examiner**

MADELINE GONZALEZ

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 6-10 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-10 and 18-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

In response to applicant's amendment dated February 12, 2009

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ferrante (U.S. 2,425,235).

With respect to **claims 1 and 18**, Ferrante discloses a filter, as shown in Fig. 1, having:

- a support structure 11 defining a rectangular opening;
- woven wire cloth 12 of orthogonal warp and weft wires;

- wherein the cloth 12 is bonded to the support structure 11 (see col. 2, lines 40-44) and extends in a tensioned state across the opening (see col. 1, lines 27-34);
- the cloth 12 has rectangular/square openings in the weave, as shown in Fig. 3, formed by a greater number of warp wires 13 per unit length than there are weft wires 14 per unit length; and
- the orientation of the cloth is chosen so that the warp wires 13 extend across the width (i.e. shorter dimension) of the rectangular opening and the weft wires 14 extend across the length (i.e. longer dimension) of the rectangular opening, since this will depend on the desired size and shape of the piece of screen (see col. 3, lines 48-53).

In the alternative, it would have been obvious to one of ordinary skill to cut a piece of screen having more warp wires across the width than weft wires, as claimed by applicant, since Ferrante is already suggesting that the filter can be made by cutting a desired size and shape of screen (see col. 3, lines 48-53). Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific orientation of the cloth, i.e., chosen so that the warp wires extend across the width (i.e. shorter dimension) of the rectangular opening and the weft wires extend across the length (i.e. longer dimension) of the rectangular opening, to the filter disclosed by Ferrante, since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent

persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

Furthermore, claim 1 is considered to be a product-by-process claim since it is drawn to a product, i.e., a screen, but it includes a process step of making the product, i.e., "formed by a greater number of warp wires per unit length than there are weft wires per unit length". "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" (see MPEP 2113 [R-1], *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (FED. Cir. 1985)).

With respect to **claim 2**, Ferrante discloses wherein the rectangular opening in the support structure 11 includes a plurality of similarly dimensioned, similarly orientated and regularly arranged smaller rectangular openings or windows 15, formed by a lattice of struts criss-crossing the larger opening, and the cloth 12, 18, is bonded to the lattice struts as well as the boundary of the larger opening, as shown in Fig. 4 (see col. 1, lines 21-48).

With respect to **claim 3**, Ferrante discloses wherein the warp wires 13 are also parallel to the width dimension (i.e. the shorter sides) of the smaller rectangular

openings, as shown in Fig. 2, and since this will depend on the desired size and shape of the selected piece of screen (see col. 3, lines 48-53 of Ferrante)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-10 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrante (U.S. 2,425,235).

**Claims 6-10 and 19-23** include dimensional limitations, such relative size and cross-sectional area of the wires and the specific shape of the wires.

Ferrante **lacks** the specific shape and dimensional limitations.

The specific dimensional limitations claimed by applicant, are considered to be nothing more than a choice of engineering skill, choice or design that a person having ordinary skill in the art would have found obvious during routine experimentation based among other things, on desired accuracy, since the courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device was not patentably distinct

from the prior art device (see *In re Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (FED. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984)).

With respect to the specific shape of the wires: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the wires disclosed by Ferrante with a circular cross-section since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

Claims 1-3, 6-10 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Ferrante (U.S. 2,425,235) and Baltzer et al. (U.S. 5,944,197) [hereinafter Baltzer].

With respect to **claims 1 and 18**, Ferrante teaches a filter, as shown in Fig. 1, having a support structure 11 defining a rectangular opening, a woven wire cloth 12 of orthogonal warp wires 13 and weft wires 14 bonded to the support structure 11, the cloth having rectangular/square openings 15 in the weave. Ferrante **lacks** the warp wires having a greater cross-sectional size than the weft wires and the specific orientation of the cloth.

With respect to the warp wires having a greater cross-sectional size than the weft wires: Baltzer teaches a screen 10, as shown in Fig. 1, including a plurality of warp filaments 12, 14, 16 and 18, which are crossed by and interwoven with a plurality of

shute filaments (weft wires) 22, 24, 26 and 28. There are a greater number of warp filaments than weft filaments per unit or given area (see col. 4, lines 6-8) in order to enhanced screen life while maximizing the conductance of the screen (see col. 2, lines 65-67 and col. 3, lines 1-8). It would have been obvious to one of ordinary skill to provide the screen disclosed by Ferrante with more warp wires than weft wires as taught by Baltzer in order to enhanced screen life while maximizing the conductance of the screen (see col. 2, lines 65-67 and col. 3, lines 1-8).

With respect to the specific orientation of the cloth: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the specific orientation of the cloth, i.e., chosen so that the warp wires extend across the width (i.e. shorter dimension) of the rectangular opening and the weft wires extend across the length (i.e. longer dimension) of the rectangular opening, to the filter disclosed by Ferrante as modified by Baltzer, since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669,149 USPQ 47 (CCPA 1966)) and since this will depend on the desired size and shape of the selected piece of screen (see col. 3, lines 48-53 of Ferrante).

Furthermore, claim 1 is considered to be a product-by-process claim since it is drawn to a product, i.e., a screen, but it includes a process step of making the product, i.e., "formed by a greater number of warp wires per unit length than there are weft wires per unit length". "Even though product-by-process claims are limited by and defined by



the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" (see MPEP 2113 [R-1], *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (FED. Cir. 1985)).

With respect to **claim 2**, Ferrante discloses wherein the rectangular opening in the support structure 11 includes a plurality of similarly dimensioned, similarly orientated and regularly arranged smaller rectangular openings or windows 15, formed by a lattice of struts criss-crossing the larger opening, and the cloth 12, 18, is bonded to the lattice struts as well as the boundary of the larger opening, as shown in Fig. 4 (see col. 1, lines 21-48).

With respect to **claim 3**, Ferrante discloses wherein the warp wires 13 are also parallel to the width dimension (i.e. the shorter sides) of the smaller rectangular openings, as shown in Fig. 2 and since this will depend on the desired size and shape of the selected piece of screen (see col. 3, lines 48-53 of Ferrante)

**Claims 6-10 and 19-23** include dimensional limitations, such relative size and cross-sectional area of the wires and the specific shape of the wires.

Ferrante and Baltzer **lack** the specific shape and dimensional limitations.

The specific dimensional limitations claimed by applicant, are considered to be nothing more than a choice of engineering skill, choice or design that a person having ordinary skill in the art would have found obvious during routine experimentation based among other things, on desired accuracy, since the courts have held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device was not patentably distinct from the prior art device (see *In re Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (FED. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984)).

With respect to the specific shape of the wires: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the wires disclosed by Ferrante and Baltzer with a circular cross-section since the courts have held that a change in shape is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration was significant (see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-3, 6-10 and 18-23 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez  
Patent Examiner  
April 13, 2009

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797